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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,875	02/16/2000	Toshikazu Nakajima	99USFP421-M.K.	5579

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EXAMINER

LEI, TSULEUN R

ART UNIT PAPER NUMBER

2684

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/504,875

Applicant(s)

NAKAJIMA, TOSHIKAZU

Examiner

T. Richard Lei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4, 5.                      6) ☐ Other: .

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Valimaa et al. (U.S. Patent 5,926,769)

Regarding Claim 1, Valimaa teaches an operation method (Col.1, Lines 7-9) of a portable phone comprising: operating any one of dial keys in a call originating mode; determining (Col.4, Lines 15-19, depression lasting greater than 1.5 seconds) whether said operated dial key is one of unspecific dial keys of said dial keys other than at least one specific dial key; changing an operation mode (Col.4, Lines 25-31) from said call originating mode to one of non-dialing operation modes when said operated dial key is one of said unspecific dial keys.

Regarding Claim 2, Valimaa teaches an operation method of a portable phone according to claim 1, wherein the non-dialing operation mode is a telephone number searching operation mode (Col.4, Lines 25-31).

Regarding Claim 3, Valimaa teaches an operation method of a portable phone according to claim 1, further comprising: executing a non-dialing operation (Col.4, Lines 25-31, read mode and store mode) other than a dialing operation in said

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non-dialing operation mode when said operated dial key is one of said unspecific dial keys.

Regarding Claim 4, Valimaa teaches an operation method of a portable phone according to claim 3, wherein said non-dialing operation is a telephone number searching operation (Col.4, Lines 25-31).

Regarding Claim 5, Valimaa teaches an operation method of a portable phone according to claim 1, wherein said at least one specific dial key is one selected from "0", "1" and "\*" (Col.3, Lines 11-13).

Regarding Claim 6, Valimaa teaches an operation method of a portable phone according to claim 1, wherein said specific dial key is only one (Col.4, Lines 8-9, key 22A).

Regarding Claim 7, Valimaa teaches an operation method of a portable phone according to claim 5, wherein said non-dialing operation is a telephone number search operation (Col.4, Lines 25-31).

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Regarding Claim 8, Valimaa teaches an operation method of a portable phone according to claim 3, wherein the number of said unspecific dial keys is at least two (Col.4, Lines 8-9, 22A or 22B), and wherein said executing a non-dialing operation includes: displaying (Fig.1, Display 20) a list of data associated with destination phone numbers, and wherein said operation method further comprises: selectively scrolling said list of data (Col.3, Lines 14-15, keys 22B, and menu scrolling and soft keys) in one of upward and downward directions in response to an operation of one of said unspecific dial keys.

Regarding Claim 9, see Claim 1 for Valimaa's teaching about the portable phone.

Regarding Claim 10, Valimaa teaches a portable phone according to claim 9, wherein said first mode is call originating mode and said second mode is a telephone number searching operation mode (Col.4, Lines 15-31).

Regarding Claim 11, see Claim 3 for Valimaa's teaching.

Regarding Claim 12, see Claim 10 for Valimaa's teaching.

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Regarding Claim 13, Valimaa teaches a portable phone according to claim 9, wherein said at least one specific dial key is one selected from "0" "1" and "#" (Col.3, Lines 11-13).

Regarding Claim 14, Valimaa teaches a portable phone according to claim 9, wherein said specific dial key is only one (Col.4, Lines 8-9, key 22A).

Regarding Claim 15, Valimaa teaches a portable phone according to claim 11, wherein said non-dialing operation is a telephone number search operation (Col.4, Lines 25-31).

Regarding Claim 16, see Claim 8 for Valimaa's teaching.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of

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this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa in view of Schroeder et al. (U.S. Patent 5,797,098).

Regarding Claim 17, Valimaa teaches a portable phone according to claim 16. Valimaa does not teach about symbol indicating the scrolling direction. Schroeder, however, discloses that a symbol indicating the scrolling direction is allocated to each of said unspecific dial keys (Schroeder, Fig.1A, 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Valimaa and Schroeder to make the operation of the keys more easily to understand.

Regarding Claim 18, Valimaa teaches a portable phone according to claim 9, wherein the number of said unspecific dial keys is at least four (Schroeder, Fig.1A, 7), and wherein said processing unit: changes the operation mode from said second



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mode to another mode in response to an operation of one of said unspecific dial keys (Col.4, Lines 25-31).

Regarding Claim 19, Valimaa teaches a portable phone according to claim 18, wherein each of said unspecific dial keys has a shape indicating the scrolling direction (Schroeder, Fig.1A, 7).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roeder (U.S. Patent 5,491,745) teaches a method and apparatus for a dual mode keypad.

Irvin (U.S. Patent 6,072,868) discloses a telephone with touch-any-key dialing mode.

Sudo et al. (U.S. Patent 5,999,827) discloses a portable phone with a scroll knob.

Kamei et al. (U.S. Patent 4,723,265) teaches a abbreviated dialer with reduced key operations.

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Tomiyori (U.S. Patent 5,305,372) discloses a mobile unit with speed dialing feature for cellular telephone network.

Kumano (U.S. Patent 5,349,629) teaches about a portable telephone with speed dialing.

Frederiksen (U.S. Patent 6,195,569) teaches a phone displaying alternative functionality menu.

Larsen et al. (U.S. Patent 6,381,468) teaches an unser interface for a hand-portable phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Richard Lei whose telephone number is 703-305-4828. The examiner can normally be reached on 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dan Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and 703-308-5403 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TRL

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October 15, 2002

Chapman  
10/18/02  
TRL